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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,587	04/11/2001	Silvia Allegro	33497	1497

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PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

EXAMINER

JACOBSON, TONY M

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/832,587

Applicant(s)

ALLEGRO ET AL.

Examiner

Tony M Jacobson

Art Unit

2644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-3 and 5-30

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


HUYEN LE
PRIMARY EXAMINER

Continuation of 2. NOTE: Applicant proposes that examiner should withdraw the finality of the prior Office action because examiner has issued a new grounds of rejection for claim 4, because claim 1 was amended to include the limitations of claim 4, thus presenting a non-substantive amendment to the subject matter of claim 4, and examiner has rejected claim 1 on a different basis. The examiner disagrees with this assertion for the following reasons: 1) In changing the transitional phrase of claim 1 from "said method consisting of:" in the original claims to "said method comprising the steps of:" in the currently rejected claims, Applicant has indeed made a substantive amendment to the claim, as the term "consisting of" is legally interpreted as a closed-ended phrase (includes only those steps explicitly recited), whereas the term "comprising" is an open-ended phrase (the invention may include other steps). Thus the scope of the amended claim is vastly different from that of original claim 4. 2) In adding the limitations of claim 4 to claim 1, Applicant has not only changed claim 1 to be (somewhat) equivalent to original claim 4, but has thereby made substantive amendment to dependent claims 2, 3, and 5-14. Thus, the examiner was required to formulate a rejection for claim 1 that could stand as a basis for formulating rejections of these dependent claims, which now contain the limitations of claim 4, where they previously did not. 3) Claim 1 stands rejected based on the same references that were applied to the rejection of claim 4 in the prior Office action; the rejection was changed from a 35 USC 103(a) rejection to a 35 USC 102(b) rejection after examiner realized, upon reconsideration of the amended claims, that he had previously read implied limitations from the specification into the claim with respect to the term "primitive grouping method", rather than interpreting the term according to its broadest common meaning.

Applicant's arguments against the rejections of claims 1, 15, and 28 are unpersuasive. Although the references relied upon in the rejection may not describe the invention in the same terms used by Applicant, they clearly do meet the extremely broad and general limitations presented in the specification and claims of Applicant, as described in the prior Office action.

The proposed amendment to claim 1 at lines 17-20 presents new issues, which would require further search or consideration, and therefore will not be allowed entry.



HUYEN LE
PRIMARY EXAMINER